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OFFICE OF PETITIONS

Bennett, et al.	:	
Application No. 08/999,106	:	DECISION ON PETITION
Filing Date: 29 December, 1997	:	
Attorney Docket No. 2632//8285/162	:	

This is a decision on the renewed petition filed on 28 November, 2005, alleging unintentional delay under 37 C.F.R. §1.137(b).

NOTE: Petitioner styled his paper as a "Petition to Withdraw Unintentional Abandonment ..." and appears to confuse a Petition to Revive under 37 C.F.R. §1.137(b) and a Request to Withdraw the Holding of Abandonment under 37 C.F.R. §1.81. Petitioner is referred to MPEP §711.02 for a discussion of these matters.

For the reasons set forth below, the petition as considered under 37 C.F.R. §1.137(b) is **GRANTED.**

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to a final Office action mailed on 12

January, 2005, with a reply due absent extension of time on or before 12 April, 2005;

- Petitioner filed an after-final reply on 10 March, 2005, an after-final amendment, which the Examiner found was not a proper reply (in that it did not *prima facie* place the application in condition for allowance¹), and on 4 October, 2005, the Examiner mailed an Advisory Action;
- the instant application went abandoned after midnight 12 April, 2005;
- the Office mailed the Notice of Abandonment on 4 October, 2005;
- on 19 October, 2005, Petitioner filed the instant petition (with fee), made the statement of unintentional delay, and submitted a Notice of Appeal (with fee) as the required reply.

Petitioner's argument is considered below.

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).²

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.³

Delays in responding properly raise the question whether delays are unavoidable.⁴ Where there is

¹ A proper reply is a an amendment *prima facie* placing the application in condition for allowance, a Notice of Appeal, or RCE (with fee and submission). (See: MPEP §711.03(c).)

² 35 U.S.C. §133 provides:
35 U.S.C. §133 Time for prosecuting application.
Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

³ Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

⁴ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁵ And the Petitioner must be diligent in attending to the matter.⁶ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁷))

Petitioner complains that the Examiner delayed in addressing Petitioner's after-final amendment.

Petitioner as one registered to practice before the Office:

- was and is aware that amendment after final is not of right (37 C.F.R. §1.116, MPEP §714.12, 714.13);
- knew (or could have known via online review of the application) that no Office action was mailed on or before 12 April, 2005, or the potentially extendable date of 12 July, 2005;
- could have filed over a properly dated Certificate of Mailing a Request for Continued Examination (with fee and submission) on or before 12 April, 2005, or (with a request and fee for extension of time) the potentially extendable date of 12 July, 2005.

Nonetheless, Petitioner failed to take such action as was required to maintain the application in prosecution and prevent the application from becoming abandoned by Petitioner.

The requirements for a grantable petition under 37 C.F.R. §1.137(b) are the petition and fee, a statement of unintentional delay, a reply, and--where appropriate--a terminal disclaimer and fee.

Petitioner appears to have satisfied the regulatory requirements under 37 C.F.R. §1.137(b).

⁵ See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁶ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

⁷ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

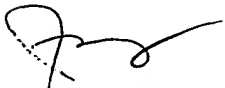
CONCLUSION

The petition under 37 C.F.R. §1.137(b) hereby is **granted**.

The instant application is released to Technology Center 2700 for to await Petitioner's filing of the Appeal Brief (with fee) within two (2) months of the mailing of this decision in concert with the regulations at 37 C.F.R. Part 41, and in particular at 37 C.F.R. §41.4, §41.37 and §41.66.

Extensions of time are available only on showing of good cause under 37 C.F.R. §41.4.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



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